

**Response**

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Serial No.: 10/633,766

Confirmation No.: 5109

Filed: 4 August 2003

For: INTAKE DEVICE FOR USE WITH INTERNAL COMBUSTION ENGINES**Remarks**

The Office Action mailed 13 July 2004 has been received and reviewed. No claims have been amended, cancelled, or added. Therefore, the pending claims include claims 1-54 as presented in the "Second Preliminary Amendment" filed 22 December 2003. Reconsideration and withdrawal of the rejections are respectfully requested in view of the remarks provided herein.

**Statutory Double-Patenting**

The Examiner rejected claims 1-54 under 35 U.S.C. §101 as claiming the same invention as that of claims 1-38 of U.S. Patent No. 6,073,609, or alternatively claims 1-12 of U.S. Patent No. 6,601,562, or alternatively claims 1-22 of U.S. Patent No. 6,170,460. Applicants respectfully traverse the Examiner's rejection.

As stated in MPEP 804, a reliable test for statutory double patenting is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. Or, as further stated in MPEP 804, "Is there an embodiment of the invention that falls within the scope of one claim, but not the other?" Such is the case with respect to each of the pending claims 1-54. There is clearly an embodiment that falls within the scope of one claim, but not the other? For example, an embodiment that falls within the scope of claim 1 of the pending application need not fall within the scope of any of the independent claims 1, 19-21, or 30 of U.S. Patent No. 6,073,609. Further, an embodiment that falls within the scope of claim 1 of the pending application need not fall within the scope of either of independent claims 1 and 12 of U.S. Patent No. 6,170,460. Yet further, an embodiment that falls within the scope of claim 1 of the pending application need not fall within the scope of claim 1 of U.S. Patent No. 6,601,562.

No specificity of the double patenting rejection was provided by the Examiner. As such, and in view of the above, Applicants assert that the question, "Is there an embodiment of the invention that falls within the scope of one claim, but not the other?", can be answered in the affirmative with respect to each of the other pending claims 2-54 as well claim 1. As such, the

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double patenting rejection is improper with respect to claims 1-54, and it is respectfully requested that the statutory double patenting rejection be withdrawn.

**Non-statutory Double-Patenting Rejection**

The Examiner has not provided a rejection under the judicially created doctrine of obviousness-type double patenting. However, if such a rejection is issued, Applicants will consider providing a suitable terminal disclaimer to overcome such a rejection.

In order to speed prosecution, if such an obviousness-type double patenting rejection is to be issued, then Applicants request a telephone conference such that they have an opportunity to provide by facsimile a terminal disclaimer to overcome the rejection.

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Summary

It is respectfully submitted that the pending claims are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for  
Buswell et al.

By

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CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that the Transmittal Letter and the paper(s), as described hereinabove, are being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Mail Stop Amendment, Commissioner for Patents, Attn: Examiner Solis, P.O. Box 1450, Alexandria, VA 22313-1450, on this 27<sup>th</sup> day of September, 2004, at 2:00pm (Central Time).

By:

Name:

JACQUELYN K. TRUBISCH